

Docket No. DELME-P2739

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of: Dan W.C. Delmer

Serial No.: 09/904,975

Art Unit: 3679

Filed: July 12, 2001

Examiner: Aaron M. Dunwoody

For: COUPLING FOR PIPE AND RELATED METHODS

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

**PETITION UNDER 37 C.F.R. 1.181 TO WITHDRAW NOTIFICATION OF NON-
COMPLIANT APPEAL BRIEF**

Sir:

Pursuant to 37 C.F.R. 1.181, Appellant respectfully petitions the Director to withdraw the September 3, 2009 Notification of Non-Compliant Appeal Brief filed June 3, 2009. In view of the impending October 3, 2009 deadline to file an amended brief or other appropriate correction in order to avoid dismissal of the appeal (MPEP §1205.03), Appellant respectfully requests that the Director expedite his review of this Petition so that Appellant will have sufficient time to meet that deadline if such review does not result in a resolution regarding the holding of noncompliance.

Certificate of Transmission

I hereby certify that this correspondence is being filed electronically via EFS with the Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on the date indicated below.
/Alison L. Vass/

Alison L. Vass, Reg. No. 63,078

September 17, 2009

DATE

The basis for this petition is that Appellant disagrees with the holding of noncompliance of the June 3, 2009 Appeal Brief. Among other things, Appellant respectfully submits that the Appeal Brief is in compliance with the new format for appeal briefs filed under the Final Rules for Ex Parte Appeals as published in the June 10, 2008 *Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals*; Final Rule, 73 FR 32938 (attached hereto in support thereof). As indicated in the November 20, 2008 clarification notice on the effective date provision of the Final Rule, **the Office will NOT hold an appeal brief as non-compliant solely for following the new format** even though it is filed before the effective date (*see Clarification of the Effective Date Provision in the Final Rule for Ex Parte Appeals*; 73 FR 70282; attached hereto in support thereof). In that regard, Appellant respectfully requests that the Notification of Non-Compliant Appeal Brief be withdrawn since Appellant's June 3, 2009 Appeal Brief was filed in compliance with the new format for appeal briefs filed under the Final Rules for Ex Parte Appeals (Rule Bd.R. 41.37), as discussed in detail below.

In accordance with 37 CFR 1.181(b), enclosed in support of this Petition is Appellant's June 3, 2009 Appeal Brief along with a copy of the Notification of Non-Compliant Appeal Brief dated September 3, 2009, the June 10, 2008 Federal Register Notice (73 FR 32938) and the November 20, 2008 Federal Register Notice (73 FR 70282) in support thereof.

Appellant respectfully requests that the holding of noncompliance of Appellant's June 3, 2009 Appeal Brief be reviewed based on the following statement of facts

(numbering corresponds to the checklist marked by the Examiner in the September 3, 2009 Notification of Non-Compliant Appeal Brief; appended hereto in support thereof):

1. The Examiner alleges that *the brief does not contain the items required under 37 CFR 41.37(c), or the items are not under the proper heading or in the proper order.*

Among other things, Appellant respectfully submits that Bd.R 41.37(e) provides that an appeal brief must contain, under appropriate headings and in the order indicated, the following items: (1) statement of the real party in interest, (2) statement of related cases, (3) jurisdictional statement, (4) table of contents, (5) table of authorities, (6) [reserved], (7) status of amendments, (8) grounds of rejection to be reviewed, (9) statement of facts, (10) argument, and (11) an appendix containing (a) claims section, (b) claim support and drawing analysis section, (c) means or step plus function analysis section, (d) evidence section, and (e) related cases section (*see* 73 FR 32938, pg. 32941, col. 1-2).

In that regard, Appellant respectfully submits that since the Appeal Brief filed June 3, 2009 contains all the items required under Bd.R 41.37(e), under appropriate headings and in the order indicated, the Appeal Brief is in compliance with the provisions of 37 CFR 41.37(c) (*see* June 3, 2009 Appeal Brief at pgs. 5-6, Table of Contents).

2. The Examiner alleges that *the brief does not contain a statement of the status of all claims, (e.g., rejected, allowed, withdrawn, objected to, canceled), or does not identify the appealed claims (37 CFR 41.37(c)(1)(iii)).*

Among other things, Appellant respectfully submits that Bd.R. 41.37(p) requires an appeal brief to contain a “claims section” in the appendix which consists of an accurate clean copy in numerical order of all claims pending in the application proceeding on appeal. The claims section in the appendix should include ALL pending claims, not just those under rejection. Also, the status of each claim is required to be indicated (e.g. 1 (rejected), 2 (withdrawn), 3 (objected to), 4 (canceled), and 5 (allowed)) (*see* 73 FR 32938, pg. 32943, col. 3).

Furthermore, Appellant respectfully submits that Bd.R. 41.37(m) requires an appeal brief to set out the grounds of rejection to be reviewed, including the claims subject to each rejection (*see* 73 FR 32938, pg. 32942, col. 1).

In that regard, Appellant respectfully submits that since the Appeal Brief filed June 3, 2009 contains the claims section required under Bd.R. 41.37(p), including ALL the pending claims and the status of each claim indicated (*see* June 3, 2009 Appeal Brief at pg. 43), and contains the grounds of rejection to be reviewed required under Bd.R. 41.37(m), including the claims subject to each rejection (*see* June 3, 2009 Appeal Brief at pg. 9), the Appeal Brief is in compliance with the provisions of 37 CFR 41.37(c)(1)(iii).

4. The Examiner alleges that *(a) the brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the*

drawings, if any by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).

Among other things, Appellant respectfully submits that Bd.R 41.37(r) requires an appeal brief to contain a “claim support and drawing analysis section” which replaces Rule 41.37(c)(1)(v) which requires a concise explanation of the subject matter defined in each of the independent claims on appeal. The claim support section, for each independent claim involved in the appeal and each dependent claim argued separately, requires an annotated copy of the claim indicating in bold face between braces ({}) after each limitation where, by page and line or paragraph numbers the limitation is described in the specification as filed. The section also requires that a drawing analysis consist of an annotated copy of the claim in numerical sequence, indicating in bold face between braces after each limitation where, by reference or sequence residue number, each limitation is shown in the drawing or sequence (*see* 73 FR 32938, pg. 32943, col. 3).

Furthermore, Appellant respectfully submits that Bd.R. 41.37(s) requires an appeal brief to contain a “means or step plus function analysis section” which replaces the requirement of Rule 41.37(c)(1)(v) relating to identification of structure, material or acts for means or step plus function claim limitations contained in appealed claims (*see* 73 FR 32938, pg. 32944, col. 1-2).

In that regard, Appellant respectfully submits that since the Appeal Brief filed June 3, 2009 contains the “claims support and drawing analysis section” required under Bd.R 41.37(r) (*see* June 3, 2009 Appeal Brief at pg. 54), and the “means or step plus function analysis section” section required under Bd.R. 41.37(s) (*see* June 3, 2009 Appeal Brief at pg. 67), the Appeal Brief is in compliance with the provisions of 37 CFR 41.37(c)(1)(v).

5. The Examiner alleges that *the brief does not contain a concise statement of each ground of rejection presented for review (37 CFR 41.37(c)(1)(vi)).*

Among other things, Appellant respectfully submits that Bd.R. 41.37(m) requires an appeal brief to set out the grounds of rejection to be reviewed, including the claims subject to each rejection (*see* 73 FR 32938, pg. 32942, col. 1).

In that regard, Appellant respectfully submits that since the Appeal Brief filed June 3, 2009 contains the grounds of rejection to be reviewed required under Bd.R. 41.37(m), including the claims subject to each rejection

(see June 3, 2009 Appeal Brief at pg. 9), the Appeal Brief is in compliance with the provisions of 37 CFR 41.37(c)(1)(vi).

6. The Examiner alleges that *the brief does not present an argument under a separate heading for each ground of rejection on appeal (37 CFR 41.37(c)(1)(vii)).*

Among other things, Appellant respectfully submits that Bd.R 41.37(o) requires that an appeal brief contain an argument comprising an analysis explaining, as to each rejection to be reviewed, why appellant believes the Examiner erred. The analysis must address all the points made by the Examiner with which the appellant disagrees. Where an argument has previously been presented to the Examiner, the analysis would have to identify where any argument being made to the Board was made in the first instance to the Examiner. In addition, Bd.R. 41.37(o) also requires that each rejection for which review is sought shall be separately argued under a separate heading (see 73 FR 32938, pg. 32942, col. 3 to pg. 32943, col. 3).

In that regard, Appellant respectfully submits that the Appeal Brief filed June 3, 2009 contains a comprehensive analysis explaining why the Examiner is believed to have erred for each rejection to be reviewed on appeal, as required by Bd.R. 41.37(o). In addition, the analysis identifies where each argument being made to the Board was made in the first instance to the Examiner. Furthermore, each rejection for which review is sought is separately argued under a separate heading (see June 3, 2009 Appeal Brief at

pgs. 22-41). Accordingly, the Appeal Brief is in compliance with the provisions of 37 CFR 41.37(c)(1)(vii).

7. The Examiner alleges that *the brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 41.37(c)(1)(viii))*.

In that regard, Appellant respectfully submits that Bd.R. 41.37 does not require a copy of the appealed claims as an appendix. Instead, Bd.R. 41.37(r) requires a “claims support and drawing analysis section” which requires an annotated copy of the claim for each independent claim involved in the appeal and each dependent claim argued separately. Among other things, according to Bd.R. 41.37(o)(2), the Board will only consider arguments that address claims set out in this “claim support and drawing analysis section” (*see* 73 FR 32938, pg. 32943, col. 2 & 3).

Accordingly, Appellant respectfully submits that the Appeal Brief filed June 3, 2009 is in compliance with Bd.R. 41.37, and therefore should not be held to be non-compliant on the basis that it follows the new format.

10. The Examiner alleges that *(1) it is not clear which claims are directed to the arguments presented on pages 11-22 of the instant brief; (2) stating that the Examiner has failed to disclose a particular feature is not an argument; (3) only claims on appeal should be listed in the claims appendix, and claim status headings, such as “rejected”, should not be applied; and (4) Related Proceedings Appendix is missing.*

In response, Appellant respectfully submits that the Examiner's allegations above are inaccurate. With regard to item 1, Appellant respectfully submits that Bd.R. 41.37(n) requires a "statement of facts" section in which Appellant should set out in an objective and non-argumentative manner, the material facts relevant to the rejections on appeal, preferably in numbered paragraphs (*see* 73 FR 32938, pg. 32942, col. 1-2).

In that regard, Appellant respectfully submits that the Appeal Brief filed June 3, 2009 contains a "statement of facts" section in compliance with Bd.R. 41.37(n) which sets out the material facts relevant to the rejections on appeal in numbered paragraphs (*see* June 3, 2009 Appeal Brief at pg. 10). Furthermore, Appellant respectfully submits that paragraphs 2.1.1 to 2.1.12 (of pages 11-16 of the "statement of facts" section) are directed to describing what is actually disclosed by the prior art references, and are not intended to be directed to any particular claim. Among other things, Appellant respectfully submits that this form is consistent with the requirements for the "statement of facts" section under Bd.R. 41.37(n). Accordingly, Appellant respectfully submits that the Examiner's assertions are inaccurate and improper, and should not be used as a basis for holding the Appeal Brief as non-compliant.

In addition, with regard to item 2, Appellant respectfully submits the argument that the Examiner has failed to *disclose a particular feature* is never relied upon in Appellant's Appeal Brief filed June 3, 2009. Among other

things, Appellant DOES make the following arguments in the Appeal Brief, all of which are appropriate and proper arguments regarding why the Examiner is believed to have erred in rejecting the claims: (A) “*the Examiner has Failed to Establish that Claims 2, 5, 6, 43-47, 49 and 50 are anticipated by Graves under 35 U.S.C. §102(e)*” (see June 3, 2009 Appeal Brief at page 22, heading); (B), “*the Examiner has failed to show that a characteristic of the claims not disclosed in the Graves reference are inherent*” (see June 3, 2009 Appeal Brief at page 22, lines 7-9); (C) “*Graves does not anticipate Claims 2, 5, 6, 43-47, 49 and 50, since the Examiner has failed to show that a characteristic not disclosed in Graves is inherent*” (see June 3, 2009 Appeal Brief at page 33, heading); (D) “*the Examiner has failed to provide (and indeed cannot provide) any such prima facie showing of inherency to support the anticipation rejection*” (see June 3, 2009 Appeal Brief at page 33, lines 16-18); (E) “*the Examiner has failed to show that a characteristic not disclosed in the Graves reference is inherent*” (see June 3, 2009 Appeal Brief at page 34, lines 8-9); (F) “*the Examiner has Failed to Establish that Claims 3,7, 48 and 51-53 are unpatentable over Graves in view of Fochler under 35 U.S.C. §103(a)*” (see June 3, 2009 Appeal Brief at page 36, heading); (G) “*the Examiner has failed to explain why one of ordinary skill in the art would be led to combine the teachings of Graves and Fochler*” (see June 3, 2009 Appeal Brief at page 36, lines 8-9); (H) “*the Examiner has failed to articulate any reason why one of ordinary skill in the art would be led to combine the*

*teachings of the references (or that they even CAN be combined)” (see June 3, 2009 Appeal Brief at page 38, heading); and (I) “the Examiner has failed to provide articulated reasoning for combining Graves with Fochler to provide an internal non-corrugated liner” (see June 3, 2009 Appeal Brief at page 41, lines 4-5). Appellant respectfully submits that NONE of the above arguments in any way suggest that the Examiner has failed to *disclose a particular feature*, and therefore Appellant respectfully submits that the Examiner’s assertions in that regard are inaccurate and improper, and should not be used as a basis for holding the Appeal Brief as non-compliant.*

Furthermore, with regard to item 3, Appellant respectfully submits that Bd.R. 41.37(p) requires an appeal brief to contain a “claims section” in the appendix which consists of an accurate clean copy in numerical order of all claims pending in the application proceeding on appeal. The claims section in the appendix should include ALL pending claims, not just those under rejection. Also, the status of each claim is required to be indicated (e.g. 1 (rejected), 2 (withdrawn), 3 (objected to), 4 (canceled), and 5 (allowed)). Furthermore, Bd.R. 41.37 does NOT require a copy of the appealed claims as an appendix. Instead, Bd.R. 41.37(r) requires a “claims support and drawing analysis section” which requires an annotated copy of the claim for each independent claim involved in the appeal and each dependent claim argued separately (see 73 FR 32938, pg. 32943, col. 3).

Appellant respectfully submits that the Appeal Brief filed June 3, 2009 does contain a “claims section” in compliance with Bd.R. 41.37(p) (*see* June 3, 2009 Appeal Brief at pg. 43) and a “claims support and drawing analysis section” in compliance with Bd.R. 41.37(r) (*see* June 3, 2009 Appeal Brief at pg. 54). Accordingly, Appellant respectfully submits that the Examiner’s assertions are inaccurate and improper, and should not be used as a basis for holding the Appeal Brief as non-compliant.

Finally, with regard to item 4, Appellant respectfully submits that Bd.R. 41.37(g) requires a “statement of related cases” section. The statement would encompass all prior or pending appeals, interferences or judicial proceedings known to any inventors, any attorneys or agents who prepares or prosecuted the application on appeal and any other person who was substantively involved in the preparation or prosecution of the application on appeal. In addition, Bd.R. 41.37(u) requires a “related cases section” in the appendix of an appeal brief which consists of copies of orders and opinions required to be cited pursuant Bd.R. 41.37(g) (*see* 73 FR 32938, pg. 32941, col. 2-3).

Appellant respectfully submits that the Appeal Brief filed June 3, 2009 does contain a “statement of related cases” section in compliance with Bd.R. 41.37(g) (*see* June 3, 2009 Appeal Brief at pg. 3) and a “related cases section” in the appendix in compliance with Bd.R. 41.37(u) (*see* June 3, 2009 Appeal Brief at pg. 71). Accordingly, Appellant respectfully submits that the

Examiner's assertions are inaccurate and improper, and should not be used as a basis for holding the Appeal Brief as non-compliant.

Accordingly, for the reasons stated above, Appellant respectfully submits that the Appeal Brief filed June 3, 2009 is in complete compliance with Bd.R. 41.37, and as such should not be held to be non-compliant solely on the basis that it follows the new format required by Bd.R 41.37. Therefore, Appellant respectfully petitions the Director to withdraw the Notification of Non-Compliant Appeal Brief, notice whereof is respectfully requested of the Director.

Appellant's representative believes that no fee is required for filing this petition since this petition seeks supervisory review by the Director. However, if any fees are needed in support of this Petition, the Patent Office is authorized to charge any fees due to Deposit Account No. 08-2624.

Respectfully submitted,

Date: September 17, 2009

/Alison L. Vass/
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Enclosures

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